

Serial No. 10/821,592Docket No. 117-P-1345USD3**Remarks**

Claim 2 has been cancelled without prejudice and claims 1, 3-20 and 36 have been amended. Antecedent basis for the amendments may be found in the specification at, e.g., page 3, line 28 through page 4, line 5, page 4, line 24, page 5, lines 7-10, page 6, lines 15-17 and 24-25 and page 9, lines 14-16. Following entry of this amendment, claims 1, 3-27, 36 and 37 will be pending in this application.

**Rejection of Claims 1-27 under 35 U.S.C. §102(b)**

Claims 1-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Published PCT Application No. WO 98/11168 (Hamrock et al.), on grounds maintained for the reasons of record as stated in the October 5, 2004 Office Action, and on the further grounds that:

*"Applicant's arguments filed on January 5, 2005 with respect to the rejection of claims 1-2, and 36 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) and the rejection of claims 20, 22-27 and 37 under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/1 1 168) in view of Holman et al. (US 6,444,134 B1) have been fully considered but they are not persuasive. Applicants argue that the Hamrock fails to teach a waterborne topcoat. However, the Examiner would like to point out that the patentability of a product does not depend on its method of production. If the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698,227 USPQ 964, 966 (Fed. Cir. 1985). The structure implied by the process step has been considered when assessing the patentability of the claims over the prior art, however the use of a waterborne composition is not deemed to impart distinctive structural characteristics to the final product." (see the Office Action at page 6, numbered paragraph 9).*

Applicants request reconsideration. Amended article claim 1 recites a coated floor having a strippable intermediate coating atop the floor and a "waterborne overcoat" adhered to the intermediate coating. No such coated floor is shown in Hamrock et al. Applicants are not

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claiming a coated floor based on "its method of production". Claim 1 addresses the coated floor after the overcoat has been applied and before it dries or hardens. Hamrock et al.'s UV curable composition is applied as a 100% solids formulation. It is not waterborne.

Regarding the Office Action's assertion that "the use of a waterborne composition is not deemed to impart distinctive structural characteristics to the final product", the Examiner is requested to review paragraphs 9-10 in the Declaration of Robert D. P. Hei Under 37 C.F.R. §1.132 (the "Hei Declaration") filed June 30, 2004 in parent Application Serial No. 09/560,170. The Hei Declaration discusses, *inter alia*, the visible appearance of vinyl composition flooring tiles coated with a single layer of PADLOCK™ acrylic polymer floor finish and overcoated with a single layer of UV-crosslinkable 100% solids finish ("Finish 2), low viscosity UV-crosslinkable 100% solids finish (Finish 3), waterborne UV-crosslinkable finish (Finish 4) or two-component aqueous polyurethane (Finish 5). Tiles coated with Finish 4 and Finish 5 exhibited better leveling and a better hardened finish appearance than tiles coated with the 100% solids overcoats, and without exhibiting diving (uneven gloss in a laminate finish that persists after the overcoat has dried or hardened). Applicants' recited coated floors have distinctive structural characteristics. Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1 and 3-27 as being anticipated by Hamrock et al.

**Rejection of Claims 1-27, 36 and 37 under 35 U.S.C. §102(b)**

Claims 1-27, 36 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,932,350 (Lauer et al.), on grounds that:

*"Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed from a thermoset material that is UV curable and which before cure may be a high solids composition or a waterborne composition (Column 2, lines 31-51). The UV curable*

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*coatings, after exposure to UV radiation, produce highly crosslinked coatings. It has proved difficult to adhere water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Lauer et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.*" (See the Office Action at pages 2-3, numbered paragraph 3).

Applicants request reconsideration. Lauer et al.'s coating (i) is said to be "highly crosslinked" and "preferably formed from a thermoset material" (see e.g., col. 2, lines 46-47) but Lauer et al. do not say that coating (i) "can be stripped without damaging the floor". Coatings like Lauer et al.'s coating (i) normally are permanent coatings, and are not designed to be stripped and renewed. Lauer et al.'s waterbased or aqueous coating (ii) is said to be "carbonyl functional" (see e.g., col. 3, lines 9-16) and "preferably a thermoplastic or substantially uncrosslinked copolymer when it is applied (in its uncured state) to the substrate" (see e.g., col. 4, lines 38-39) but Lauer et al. do not say that after it is dried or hardened coating (ii) "can be stripped without damaging the floor".

Lauer et al. say that the cellulosic substrate material may be selected from wood, MDF, hardboard and particle board and used in interior furniture and home fittings (see e.g., col. 5, lines 52-57), and that for such cellulosic substrates the substrate is first coated with the highly crosslinked coating (i) and then coated with the waterbased coating (ii) (see e.g., col. 5, lines 52-62). This is the approach used in all of Lauer et al.'s working examples, in which two layers of highly crosslinked coating (i) are applied to a "Masonite type hardboard substrate", sanded and UV cured (see e.g., col. 5, lines 57-65 and col. 9, line 41 through col. 10, line 38), and then a layer of coating (ii) is applied atop coating (i) and oven-dried (see e.g., col. 10, lines 39-45). These working examples do not show or suggest a coated floor of claims 1, 3-19 or 36 or a strippable laminate finish kit of claims 20-27 or 37 for at least the

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reason that the dried aqueous thermoplastic coating (ii) would not be "less strippable and more durable than the intermediate coating".

Lauer et al. also say that in another embodiment:

*"the cellulosic material is a paper material such as may be typically used in a printing or packaging application. Here, the waterbased coating (ii) may first be applied to the substrate, such as in the form of an ink, and then the cured waterbased coating (ii) and substrate are both coated with the highly crosslinked coating" (see e.g., col. 5, line 66 through col. 6, line 4; the "(ii)" at the end of line 4 appears to be an error and may have been intended to read "(i)").*

Lauer et al. do not provide any working examples showing this latter printing or packaging embodiment. However, this printing or packaging embodiment does not show or suggest a coated floor of claims 1, 3-19 or 36 or a strippable laminate finish kit of claims 20-27 or 37 for at least the reason that a "paper material such as may be typically used in a printing or packaging application" is not a floor.

Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 3-27, 36 and 37 as being anticipated by Lauer et al.

#### **Rejection of Claims 1-27 under 35 U.S.C. §102(b)**

Claims 1-27 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,494,707 (Wang et al.), on grounds that:

*"Wang et al. disclose a resilient floor covering comprising of a resilient support surface and a resilient wear surface adhered to said support surface and comprising an underlying wear layer based coat and an overlying wear layer top coat adhered to said wear layer base coat (Column 3, lines 61-68). The wear layer top coat is a hard thermoset UV curable blend of acrylates (Column 4, lines 7-10). The wear layer base coat has a thickness of 0.7 to 3.0 mils and the wear layer top coat has a thickness of 0.1 to 0.5 mils (Column 8, lines 35-45). Conventional substrate layer comprises materials typical of substrate layers found in the flooring art and include vinyl*

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*compositions (Column 9, lines 59-66). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Wang et al, given that the chemical composition of the coatings and the structure of the laminate as taught by Wang et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.”* (see the Office Action at pages 3-4, numbered paragraph 4).

Applicants request reconsideration. Wang et al. is similar to the previously-cited Bolgiano et al. reference in that it involves a factory-applied finish (see e.g., Examples 2 through 4) for no-wax flooring (see e.g., col. 4, lines 16-20). Wang et al.'s resilient wear surface includes a wear layer base coat and wear layer top coat. Wang et al. do not say that either the wear layer base coat or wear layer top coat “can be stripped without damaging the floor”. Wang et al. say that the wear layer base coat and wear layer top coat preferably are cross-linked sufficiently to be insoluble in certain named solvents (see e.g., col. 8, lines 62-65). Coatings like Wang et al.'s resilient wear surface normally are permanent coatings, and are not designed to be stripped and renewed.

Although Wang et al. say their wear layer base coat may be “water based” or “solvent based” (see e.g., col. 8, lines 66-67), Wang et al. make no such statement concerning their wear layer top coats which appear to be 100% solids UV curable materials (see e.g., col. 9, lines 14-38, Example 5 at col. 16, lines 42-49 and Example 6 at col. 16, lines 64-67). Wang et al. do not show or suggest a coated floor of claims 1 or 3-19 or a strippable laminate finish kit of claims 20-27 for at least the reason that Wang et al.'s wear layer top coat is not a “waterborne overcoat”.

Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1 and 3-27 as being anticipated by Wang et al.

Serial No. 10/821,592Docket No. 117-P-1345USD3**Rejection of claims 20, 22-27 and 37 under 35 U.S.C. §103(a)**

Claims 20, 22-27 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hamrock et al. in view of U.S. Patent No. 6,444,134 B1 (Holman et al.), on grounds maintained for the reasons of record as stated in the October 5, 2004 Office Action, and on the further grounds quoted above from page 6 of the Office Action. Applicants request reconsideration. Holman et al. do not describe finishes like those described by Hamrock et al., and do not relate to a strippable laminate finish kit as recited in rejected claims 20, 22-27 and 37. Holman et al. describe a hardwood floor refinishing system meant to avoid the sanding step that typically is required when completely removing and renewing a hardwood floor finish (see e.g., col. 1, lines 9-35 and col. 2, lines 18-20). Holman et al. say that their renewal finish has "chemical resistance" (see e.g., col. 4, lines 31-35 and 59-63). A person having ordinary skill in the floor finish art who consulted Holman et al. would not use Holman et al.'s renewal finish if a finish that "can be stripped without damaging the floor" was desired. Chemical resistance is contrary to strippability and a reason not to use Holman et al.'s renewal finish. It is also a reason not to use Holman et al.'s renewal finish in place of Hamrock et al.'s radiation curable overcoat. In Dr. Hei's words:

*"In my opinion a person having ordinary skill in the resilient floor finish art would not substitute a part of Holman et al.'s system (namely, the chemically resistant water-based renewal finish) for a part of Hamrock et al.'s system (namely, the 100 % solids radiation curable topcoat). Doing so would involve substituting a component of a hardwood floor refinishing system that is not said to be strippable for the upper layer of a vinyl floor coating system that should be strippable. Doing so would also be contrary to Hamrock et al.'s statements that finishes with an aqueous emulsion formulation, low solids content or an air drying requirement are "not completely satisfactory". Moreover, doing so would be contrary to the ordinary expectation of persons skilled in the resilient floor finish art that a "chemically resistant" coating should not be used where strippability is required. Thus for at least these reasons I do not believe that a person having ordinary skill in the resilient floor finish art would*

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*combine Hamrock et al. and Holman et al. as proposed in the Office Action.*” (see paragraph 8 in the Hei Declaration).

Accordingly, Hamrock et al. and Holman et al. should not be combined as proposed in the Office Action. Applicants accordingly request withdrawal of the 35 U.S.C. §103(a) rejection of claims 20, 22-27 and 37 as being unpatentable over Hamrock et al. in view of Holman et al.

**Rejection of claim 21 under 35 U.S.C. §103(a) over**

**Hamrock et al. in view of Holman et al. and Koreltz et al.**

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hamrock et al. in view of Holman et al. and Published PCT Application No. WO 94/22965 (Koreltz et al.), on grounds maintained for the reasons of record as stated in the October 5, 2004 Office Action. As noted above and in the Hei Declaration, a person having ordinary skill in the floor finish art who consulted Hamrock et al. would not adhere a waterborne overcoat to Hamrock et al.'s intermediate coating in view of Hamrock et al.'s warnings regarding the disadvantages of aqueous emulsion based finishes. As also noted above and in the Hei Declaration, a person having ordinary skill in the floor finish art who consulted Holman et al. would not use Holman et al.'s chemically resistant renewal finish to make a strippable laminate finish kit for at least the reason that chemical resistance is contrary to strippability. Koreltz et al. does not provide a proper basis for ignoring these issues, and would not make obvious the strippable laminate finish kit recited in claim 21. Paragraphs 11-12 in the Hei Declaration show that Koreltz et al.'s stripper would not remove a single coat of Finish 4 or Finish 5, both of which are highly durable finishes. A person having ordinary skill in the resilient floor finish art would assume that Koreltz et al.'s stripping agents could not be used to remove Holman et al.'s chemically resistant renewal finish, and would not combine Hamrock et al., Holman et al. and Koreltz et al. as proposed in the Office Action. Applicants accordingly request withdrawal of the 35 U.S.C. §103 (a) rejection of claim 21 as being unpatentable over Hamrock et al. in view of Holman et al. and Koreltz et al.

Serial No. 10/821,592Docket No. 117-P-1345USD3**Rejection of claim 21 under 35 U.S.C. §103(a) over****Lauer et al. in view of Koreltz et al.**

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lauer et al. in view of Koreltz et al., on grounds that:

*"Lauer et al., as discussed above, do not state that their floor finishing system further comprises a strip agent.*

*"However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).*

*"Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Lauer et al. given that such compositions can be used to remove multiple coatings." (see the Office Action at pages 4-5, numbered paragraph 7*

Applicants request reconsideration. Lauer et al.'s coating (i) is said to be highly crosslinked and preferably formed from a thermoset material. As noted above, coatings like Lauer et al.'s coating (i) normally are permanent and are not designed to be stripped and renewed. A person having ordinary skill in the floor finish art would assume that Koreltz et al.'s stripping agents could not be used to remove Lauer et al.'s coating (i), and would not combine Lauer et al. and Koreltz et al. as proposed in the Office Action. Applicants accordingly request withdrawal of the 35 U.S.C. §103 (a) rejection of claim 21 as being unpatentable over Lauer et al. in view of Koreltz et al.

**Double Patenting Rejection**

Claims 1-7, 11-16, 18 and 19 were provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-7, 11-16, 18 and 19 of copending Application No. 10/821,560. Applicants request reconsideration. The claims in the two applications are not identical. Claim 2 in each application has been cancelled. Claims 1, 3-7, 11-16, 18 and



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19 in the present application recite a coated floor with a waterborne "overcoat" that is "adhered to" a strippable intermediate coating and is "more wear-resistant" than the intermediate coating. Claims 1, 3-7, 11-16, 18 and 19 in the '560 application recite a coated floor with a waterborne "topcoat" that is "atop" a strippable intermediate coating and is "more durable" than the intermediate coating. Applicants accordingly request withdrawal of the double patenting rejection of claims 1, 3-7, 11-16, 18 and 19 under 35 U.S.C. §101.

### Conclusion

Hamrock et al. uses a 100% solids radiation curable overcoat. Applicants have shown that a waterborne overcoat can provide a laminate finish exhibiting better leveling, a better final appearance and an absence of diving compared to a laminate finish formed from a one-part 100% solids UV curable overcoat. Applicants' recited coated floors have distinctive structural characteristics. Hamrock does not anticipate coated floor claims 1 or 3-19 or strippable laminate finish kit claims 20-27

Lauer et al. refer to but do not exemplify an embodiment in which a waterbased coating (ii) is applied to "paper material such as may be typically used in a printing or packaging application", cured, and coated with a highly crosslinked coating (i). This printing or packaging embodiment does not show or suggest a coated floor of claims 1, 3-19 or 36 or a strippable laminate finish kit of claims 20-27 or 37 for at least the reason that a "paper material such as may be typically used in a printing or packaging application" is not a floor.

Wang et al. say their wear layer base coat may be "water based" or "solvent based" but make no such statement concerning their wear layer top coats which appear to be 100% solids UV curable materials. Wang et al. do not show or suggest a coated floor of claims 1 or 3-19 or a strippable laminate finish kit of claims 20-27 for at least the reason that Wang et al.'s wear layer top coat is not waterborne.

Holman et al.'s renewal finish is said to have chemical resistance. Applicants have shown that a person having ordinary skill in the resilient floor finish art would not substitute Holman et al.'s chemically resistant water-based renewal finish for Hamrock et al.'s 100 %

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solids radiation curable overcoat. Hamrock et al. and Holman et al. should not be combined as proposed in the Office Action, and the proposed combination of Hamrock et al. and Holman et al. would not make obvious the strippable laminate finish kit of claims 20, 22-27 and 37.

A person having ordinary skill in the resilient floor finish art would know that Koreltz et al.'s stripping agents could not be used to remove Holman et al.'s chemically resistant renewal finish, and would not combine Hamrock et al., Holman et al. and Koreltz et al. as proposed in the Office Action. The proposed combination of Hamrock et al., Holman et al. and Koreltz et al. would not make obvious the strippable laminate finish kit of claim 21. For similar reasons, the proposed combination of Lauer et al. and Koreltz et al. would not make obvious the strippable laminate finish kit of claim 21.

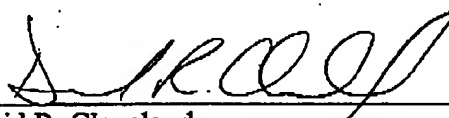
Claims 1, 3-7, 11-16, 18 and 19 in the present are not identical to claims 1, 3-7, 11-16, 18 and 19 in the '560 application.

Withdrawal of the rejections and passage of the application to the issue branch are requested. The Examiner is encouraged to telephone the undersigned attorney at 612-331-7412 to discuss any unresolved questions regarding this application.

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